

REMARKS

Claims 1-20 are pending in the present application, of which claims 1, 7, 13 and 19 are independent. After entry of the above amendments, claims 1-20 are pending, of which claims 1, 7, 14 and 19 are independent. Applicants believe that the present application is in condition for allowance, which prompt and favorable action is respectfully requested.

I. OATH AND DECLARATION

The oath and declaration was found to be defective because of the reference to the sole inventor rather than joint inventors. Applicants submit that this is a minor deficiency and request that the deficiency be waived by an examiner with full signatory authority. (MPEP 602.03). However, if the Examiner wishes, Applicants will file a new oath and declaration.

II. CLAIM OBJECTIONS

The Examiner objected to claims 1, 7 and 13 because of the informalities that the use of the article "a" before "user" should be "an." Applicants submit that it is grammatically proper and accepted to use "an" before the term "user." Accordingly, Applicants respectfully request the withdrawal of the objections.

III. REJECTION UNDER 35 U.S.C. §112

The Examiner rejected claims 5, 11 and 17 under 35 U.S.C. §112, second paragraph, as being allegedly indefinite because the term "the value" in the last line could refer to either "the exponentiated value" or "the derived value." Applicants submit that this was a minor error amounting to informalities. Accordingly, claims 5, 11 and 17 have been amended to correct the informality and not to narrow the scope of the claim. Therefore, Applicant respectfully requests the withdrawal of the rejection s under 35 U.S.C. §112.

IV. REJECTION UNDER 35 U.S.C. §103

The Examiner rejected claims 1-3, 7-9, 13-15 and 20 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,796,952 issued to Davis et al. (hereinafter "Davis") in view of U.S. Patent No. 5,841,870 issued to Fieres et al. (hereinafter "Fieres"). Claims 4, 6, 10, 12, 16 and 18 are rejected under 35 U.S.C. §103 as being unpatentable over Davis and Fieres and in

further view of *Handbook of Applied Cryptography* by Menezes et al. (hereinafter “Menezes”). The rejection is respectfully traversed in its entirety.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim elements. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. (MPEP 2143)

Applicants respectfully submit that the Examiner’s suggested combination of the references is improper because there is no teaching or suggestion within the art to make the combination proposed by the Examiner. This is insufficient, as a matter of law, because it does not rely on the teachings of the references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Additionally, even if the references could be combined, which Applicant maintains that they cannot, the resulting combination fails to teach or suggest the claimed subject matter as set forth in independent claims 1, 7, 13 and 19.

More particularly, neither Davis nor Fieres, separately or combined, teach or suggest constructing a puzzle *in response to information received from a user* as in claims 1, 7 and 13. Also, neither Davis nor Fieres, separately or combined, teach or suggest constructing a plurality of puzzles wherein each puzzle has a solution that includes information about a respective one of the plurality of users and wherein each puzzle requires consumption of a resource to solve as in claim 19. Since neither Davis nor Fieres teach or suggest all the claim elements, Applicants respectfully submit that the Examiner has failed to set forth a prima facie case of obviousness and respectfully requests that the rejections of independent claims 1, 7, 13 and 19 be withdrawn.

Furthermore, claims 4, 6, 10, 12, 16 and 18 depend from and include all the elements cited in the independent claims 1, 7 and 13, respectively. Accordingly, Applicants submit that these claims are believed to be allowable based on their dependency from an allowable base claim as well as other novel features included therein.

Therefore, Applicants respectfully requests a withdrawal of the rejection under 35 U.S.C. §103 for at least the foregoing reasons.

V. ALLOWABLE SUBJECT MATTER

Applicants thank the Examiner for indicating that claims 5, 11 and 17 contain allowable subject matter. However, Applicant would prefer to defer rewriting the claims to include the elements of the parent claim and all intervening claims until the time at which final disposition of all claims is required.


CONCLUSION

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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